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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,118	06/23/2003	Peter T. Robertson	51865-012	7175
7590 11/21/2005 McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			EXAMINER BLECK, CAROLYN M	
			ART UNIT 3626	PAPER NUMBER

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/601,118

Applicant(s)

ROBERTSON ET AL.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 and 21-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/23/03, 6/18/04, 6/28/04</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Notice to Applicant*

1. This communication is in response to the election filed 26 September 2005. Claims 1-33 are pending. Claims 1-10 and 14-20 have been elected. Claims 11-13 and 21-33 have been withdrawn. The IDS statements filed 23 June 2003, 18 June 2004, and 28 June 2004 have been entered and considered.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
3. Claims 1-10 and 14-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(A) To satisfy the requirements of 35 U.S.C. 101, a claimed invention must be a practical application of an abstract idea, law of nature, or natural phenomenon.

Whether a claimed invention is a practical application can be identified in two ways.

First, the claimed invention "transforms" an article or physical object to a different state or thing. Second, the claimed invention otherwise produces a useful, concrete and tangible result. *State Street Bank & Trust Co. vs. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). See also The USPTO Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility,

[http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf), pages 18-23.

In this case, claim 1 fails to provide a transformation or reduction of an article to a different state or thing. Claim 1 recites accessing data and classifying the data into a plurality of risk groups. Claim 1 does not appear to transform the data into a different state or thing.

In this case, claim 1 does not provide a practical application that produces a tangible result. To satisfy the requirement of a tangible result, the claim must set forth a practical application to produce a real world result. Claim 1 recites a method that is capable of being performed mentally in its entirety. Claim 1 does not recite the storage of any data. Claim 1 still appears to be entirely an idea in a person's head. Thus, claim 1 fails to provide a real world result and is considered to be an abstract idea.

Because claim 1 fails to provide a tangible result, claim 1 is considered to be directed to non-statutory subject matter.

(B) Similar analysis can be applied to independent claims 14 and 18 as well as dependent claims 2-10, 15-16, and 19-20. Therefore those claims are rejected for the same reasons as claim 1.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gice (Gice, Jon, "The Relationship Between Job Satisfaction and Workers Compensation Claims, Society of Chartered Property and Casualty Underwriters, CPCU Journal, September 1995) in view of DeTore et al. (4,975,840).

(A) As per claims 1-4, Gice teaches that personality traits of workers and automobile, bus, and taxi drivers are a major causative factor in workers compensation claims (i.e., the worker having an accident at work) and automobile accidents. The personality traits including impulsivity, aggression, depression, locus of control, and general social maladjustment. General social maladjustment is a person who is self-centered, immature, aggressive, and impulsive. (See pages 5-7).

While Gice teaches that personality traits can correlate with insurance claims, Gice does not expressly disclose a method for analyzing this personality trait data to place an insured in a risk group.

DeTore discloses a method for evaluating the insurability of a potentially insurable risk comprising:

(a) entering and accessing data in a database containing information collected from an applicant or applicants, including personal data (age, address, occupation, and income level, etc.), medical information (prior medical problems, existing conditions,

medications, etc.) and any other information received from the applicant which may have a bearing on insurability, such as depression, smoking or drinking habits, and avocations (col. 4 lines 24-35, col. 5 line 19-68, and col. 10 lines 43-54);

(b) determining a risk classification for a particular applicant based on data collected including information which may have a bearing on insurability, such as depression, smoking or drinking habits, and certain types of psychological stresses (col. 5 lines 19-68 and col. 10 lines 43-54); and

(c) wherein the risk has been defined as the possibility of loss or injury, wherein the possible losses include loss of life, health, property, or finances, wherein in order for the risk to be insurable, the element of chance must be present, i.e., the loss should be caused by an uncertain future event which is not intentionally caused, and wherein property is at risk from environmental sources such as fires and storms as well as from accidents, theft, and vandalism, and wherein information collected in the questionnaire includes motor vehicle reports (col. 1 lines 5-54 and col. 5 lines 19-60).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the features of Gice within the method of DeTore with the motivation of providing an automated system for assessing risk without the aid or intervention of underwriters, thus improving efficiency, quality, and consistency of decisions (DeTore; col. 6 lines 3-10).

It is respectfully submitted that in order to determine whether or not to insure a prospective insuree for motor vehicle insurance and malpractice insurance the probability of an uncertain future event (i.e., causing or having a car accident,

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malpractice by a medical professional) is predicted. The skilled artisan would have found it an obvious modification to include risk classification relating to the aforementioned types of insurance with the motivation of ensuring insurance companies are able to properly assess the risk of insuring a possible driver for motor vehicle insurance and a medical professional for malpractice insurance, thus reducing financial losses of the company (DeTore; col. 1 lines 5-55).

(B) As per claim 5, Gice discloses the personality traits including social maladjustment, impulsivity, aggression, depression, and locus of control (pages 2-3).

(C) As per claim 6, Gice discloses correlating age, gender, race, marital status, and educational achievement level with insurance claims (pages 1-2).

(D) As per claim 7, DeTore discloses producing an underwriting decision using the personal data (age, address, occupation, and income level, etc.), medical information (prior medical problems, existing conditions, medications, etc.) and any other information received from the applicant which may have a bearing on insurability, such as depression, smoking or drinking habits, and avocations (col. 4 lines 24-35, col. 5 line 19-68, and col. 10 lines 43-54) to determine premiums (col. 13 lines 1-16 and col. 14 lines 13-68). The motivation for combining DeTore within Gice is given above in claim 1, and incorporated herein.

(E) As per claim 8, DeTore discloses collecting data from an applicant by having an applicant complete an application form or enter information directly from a keyboard or other input device (Fig. 3 and 8, and col. 6 lines 36-58). As per the recitation of "personality traits," note the teachings of the Gice reference as discussed in claim 1. The motivation for combining DeTore within Gice is given above in claim 1, and incorporated herein.

(F) As per claim 9, DeTore discloses administering a questionnaire to obtain information from an applicant and recording answers from an applicant on the questionnaire in response to questions relating to information about psychological stresses, avocations, and lifestyle habits (Fig. 8-10, col. 1 lines 5-55, and col. 12 line 37 to col. 13 line 45). As per the recitation of "personality traits," note the teachings of the Gice reference as discussed in claim 1. The motivation for combining DeTore within Gice is given above in claim 1, and incorporated herein.

(G) As per claim 10, Gice discloses using data regarding a person's anger or frustration (i.e., angry or frustrated), depression (i.e., depressed), social maladjustment (i.e., self-centered, immature, aggressive, and impulsive (pages 2-3). These traits all appear to constitute both a form of personality traits (pages 2-3) and a form of character traits. The remaining features are disclosed in claim 1, and are incorporated herein.



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(H) As per claims 14-16 and 18-20, Gice teaches that personality traits of workers and automobile, bus, and taxi drivers are a major causative factor in workers compensation claims (i.e., the worker having an accident at work) and automobile accidents. The personality traits including impulsivity, aggression (reads on "hostility"), depression, locus of control, and general social maladjustment (reads on "social desirability"). General social maladjustment is a person who is self-centered, immature, aggressive, and impulsive. (See pages 5-7).

While Gice teaches that personality traits can correlate with insurance claims, Gice does not expressly disclose a method for analyzing this personality trait data to place an insured in a risk group, wherein the risk classification relates to at least one of accident insurance and a likelihood of filing an accident insurance claim.

DeTore discloses a method for evaluating the insurability of a potentially insurable risk comprising:

(a) entering and accessing data in a database containing information collected from an applicant or applicants, including personal data (age, address, occupation, and income level, etc.), medical information (prior medical problems, existing conditions, medications, etc.) and any other information received from the applicant which may have a bearing on insurability, such as depression, smoking or drinking habits, and avocations (col. 4 lines 24-35, col. 5 line 19-68, and col. 10 lines 43-54);

(b) determining a risk classification for a particular applicant based on data collected including information which may have a bearing on insurability, such as

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depression, smoking or drinking habits, and certain types of psychological stresses (col. 5 lines 19-68 and col. 10 lines 43-54); and

(c) wherein the risk has been defined as the possibility of loss or injury, wherein the possible losses include loss of life, health, property, or finances, wherein in order for the risk to be insurable, the element of chance must be present, i.e., the loss should be caused by an uncertain future event which is not intentionally caused, and wherein property is at risk from environmental sources such as fires and storms as well as from accidents, theft, and vandalism, and wherein information collected in the questionnaire includes motor vehicle reports (col. 1 lines 5-54 and col. 5 lines 19-60).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the features of Gice within the method of DeTore with the motivation of providing an automated system for assessing risk without the aid or intervention of underwriters, thus improving efficiency, quality, and consistency of decisions (DeTore; col. 6 lines 3-10).

It is respectfully submitted that in order to determine whether or not to insure a prospective insuree for motor vehicle insurance and malpractice insurance the probability of an uncertain future event (i.e., causing or having a car accident, malpractice by a medical professional) is predicted. The skilled artisan would have found it an obvious modification to include risk classification relating to the aforementioned types of insurance with the motivation of ensuring insurance companies are able to properly assess the risk of insuring a possible driver for motor vehicle

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insurance and a medical professional for malpractice insurance, thus reducing financial losses of the company (DeTore; col. 1 lines 5-55).

As per the recitation of "likelihood of filing an accident insurance claim," it is respectfully submitted that DeTore's possibility of loss or injury (col. 1 lines 5-54 and col. 5 lines 19-60) is considered to be a form of "the likelihood of filing an accident insurance claim."

(I) Claim 17 repeats the subject matter of method claim 1, respectively, as a computer readable medium bearing instructions, which is executed by a processor rather than as a series of steps. As the underlying processes of claim 1 have been shown to be fully disclosed by the collective teachings of Gice and DeTore in the above rejections of claim 1, it is readily apparent that the system disclosed collectively by DeTore includes a computer readable medium bearing instructions, which is executed by a processor (see DeTore; Fig. 1-2, col. 63 to col. 4 line 35) to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**7. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(571) 273-8300	[Official communications]
(571) 273-8300	[After Final communications labeled "Box AF"]
(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.


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November 1, 2005

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600